UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
WINTER, JOHN M

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>15 September 2008</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-39</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-39</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

The Applicants amendment filed on September 11, 2008 is hereby acknowledged,

Claims 1-39 remain pending. A request for continued examination under 37 CFR 1.114,

including the fee set forth in 37 CFR 1.17(e), was filed in this application after final

rejection. Since this application is eligible for continued examination under 37 CFR 1.114,

and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous

Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed

on September 11, 2008 has been entered.

Response to Arguments

The Applicant states that claims 1 - 24 are directed to a non-obvious improvement over

the cited prior art, in claim 1 as amended a vendor identity code is transmitted

electronically from the vendor to the customer and the customer transmits an order to the

vendor based on the vendor code. The cited art fails to show or suggest this feature.

The Examiner states that this feature is discloses by Teper. (column 3, lines 5- 18).

The Applicants arguments in regards to claims 2,3,4, 19 and 20 are directed

material that the Applicant consideres lacking from the prior art record, however the

Examnier finds the claim langiage directed towards merely a description of the type of

data comprising the transaction code (i.e. URL , stored in the memory of a wireless

telephone). Hence, as characteristics of the transaction code do not create a functional

relationship between the transaction code and the processing system, they do not

distinguish the claims from the prior art of Beattie et al. (*In re Gulack*, 217 USPQ 401

(Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031

(Fed. Cir. 1994); MPEP 2106.01).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-39 are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter.

Based on Supreme Court precedent and recent Federal Circuit decisions, § 101 process

must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform

underlying subject matter (such as an article or materials) to a different state or thing. If neither

of these requirements is met by the claim(s), the method is not a patent eligible process under 35

U.S.C. § 101.

Claims 1,3,4 11,14,18, 25 and 37 discloses a mere nominal recitation of technology and

fails to transform the underlying subject matter to a different state, therefore the claimed method

is non-statutory and rejected under 35 U.S.C. 101 (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981);

Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972);

Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)).

Claims 2, 5-10, 12-13, 15-17 19-24, 26-36 and 38-39 dependant upon the above rejected

claims and are rejected for at least the same reason.

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
manner in which the invention was made.

2.   Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Movalli et al

(U.S. PG Pub No. 2005/0004876 A1) ("Movalli") in view of Walker et al (U.S. PG Pub

No. 2003/0149632 A1) ("Walker") and further in view of Teper et al. (U.S. Patent

5,815,665)("Teper").

3.   As per claim 1, 18, Movalli teaches a method of electronically executing a

commercial

transaction between a customer and a vendor, the method comprising transmitting

electronically a transaction code from the customer to an electronic order processing

system associated with the vendor based on the vendor identity code; authenticating

the transaction code; identifying a commercial transaction associated with the transaction

code; and executing the identified commercial transaction (see figs 4, 5, paragraphs 0046-

0051).

Movalli fails to teach transaction between a remotely located customer and a vendor.

However, Walker teaches transaction between a remotely located customer and a vendor

(seefig 1, pps 0044, 0045). Therefore it would have been obvious to one of ordinary skill

in the art at the time the invention was made to modify Movalli's disclosure to include

Walker's transaction between a remotely located customer and a vendor because this

would have enhance the flexibility of the transaction system; furthermore the combination

of these elements does not alter their respective functions, and the combination would have

yielded predictable results to one of ordinary skill in the art at the time of the invention..

Movalli fails to teach the claimed feature of receiving the transaction code by the order

processing system associated with the vendor; identifying the user based upon the contents

of the transaction code. Teper teaches receiving the transaction code by the order

processing system associated with the vendor; identifying the user based upon the contents

of the transaction code. (around column 8, line 55, data stored by the Online broker site

includes at least "unique ID and billing history, it is obvious that items in a database would

share a common key, customer ID in the present case). Therefore it would have been

obvious to one of ordinary skill in the art at the time the invention was made to modify

Movalli et al's disclosure to include Teper teaching of authentication process because this

would allow an anonymous user to be securely authenticated without compromising the

users identity; furthermore the combination of these elements does not alter their

respective functions, and the combination would have yielded predictable results to one of

ordinary skill in the art at the time of the invention.

Movalli fails to teach the claimed feature of transmitting electronically an vendor

identity code from the vendor to a customer; Teper teaches transmitting electronically an

vendor identity code from the vendor to a customer. (column 3, lines 5- 18).Therefore it

would have been obvious to one of ordinary skill in the art at the time the invention was

made to modify Movalli et al's disclosure to include Teper teaching of authentication

process because this would allow an anonymous user to be securely authenticated without

compromising the users identity; furthermore the combination of these elements does not

alter their respective functions, and the combination would have yielded predictable results

to one of ordinary skill in the art at the time of the invention.

4.   As per claim 2 and 20, Movalli teaches a method where the transaction code is

comprised of a telephone dialing sequence, and applying the transaction code dial

sequence to a line associated with a public switched telephone network (see figs 1).

5.   As per claim 3 and 21, Movalli teaches the limitations of claim 1, and

additionally; a method in which the transaction code is comprised of a Universal Resource

Locator, and the transaction code is transmitted via the Internet (see fig 1, 2, 3).

6.   As per claim 4 and 19 Movalli teaches the limitations of claim 1, and

additionally; a method of transmitting a transaction code that has been previously stored

within digital memory associated with a wireless telephone via a wireless communications

network (see fig 1).

7.   As per claim 5, Movalli teaches a method Of identifying the contents of a user

identification data field within the transaction code; locating the user identification data

field contents within a database accessible by the order processing system (see paragraphs

0046- 0051).

8.   As per claim 6, Movalli teaches a method of identifying the contents of a security

code field within the transaction code; determining that the received transaction code is

authentic when the contents of the security code field correspond to a previously-

configured security code associated with the contents of the user identification data field,

which previously-configured security code is stored within a database accessible by the

order processing system (see paragraphs 0046-0051).

9.   As per claim 7, Movalli teaches a method of identifying a decryption key

associated

with the contents of the user identification data field; decrypting at least a portion of the

transaction code using the identified decryption key; determining whether the decrypted

portion of the transaction code is valid (see paragraphs 0046-0051).

10.   As per claim 8, Movalli teaches a method of identifying a decryption key based

upon the identity of the user; decrypting at least a portion of the transaction code using the

decryption key (see paragraphs 0054).

11.   As per claim 9, Movalli teaches a method of determining the contents of a

transaction identification field within the transaction code; locating the contents of the

transaction identification field within a database accessible by the order processing system;

identifying the nature of the commercial transaction based upon information within the

database associated with the contents of the transaction identification field(see paragraphs

0046-0051).

12.   As per claim 10, Movalli teaches a method of determining the contents of a

transaction identification field within the transaction code; identifying the nature of the

commercial transaction based upon information within the transaction identification field

(see paragraphs 0046-0051)

13.   As per claim 11, Movalli teaches a method of locating a record within a database

associated with the order processing system based upon the identity of the user; retrieving

details of the commercial transaction from the database record associated with the user

(see paragraphs 0046-0051).

14.   As per claim 12, Movalli teaches a method maintained within a point of sale

computer

system operated by the vendor (see fig 1, 2).

15.   As per claim 13, Movalli teaches a method of entering the identified commercial

transaction into a point of sale computer system operated by the vendor (see fig 1).

16.   Claims 14-39 are in parallel with claims 1-13 and are rejected for at least the same

reasons, since claims 14-39 disclose the same invention as claims 1-13 the examiner

submits that a restriction is not proper at this time.

Response to Arguments

17.   Applicant's arguments, with respect to the rejection(s) of claim(s) 1-39 have been

fully considered.

The Examiner states that the term "transaction code" is construed as information

relating to a transaction, This is supported by the Applicants specification , page 4 line 25

"some transaction codes may include full information describing the desired transaction

within the code.". Teper discloses accessing a database of billing history (i.e. order

processing system associated with the vendor) via unique customer ID, identifying the

user based upon the contents of the transaction code)

The Applicant states that lacking any teaching with regard to the handling of a

transaction code, one of ordinary skill in the art would not turn to the teaching of Teper in

order to

find the elements that are missing from Movalli and Walker.

The Examiner responds that in response to Applicant's argument that there is no

suggestion to combine the references, the Examiner recognizes that references cannot be

arbitrarily combined and that there must be some reason why one skilled in the art would

be motivated to make the proposed combination of primary and secondary references. In

re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a

motivation to make the modification be expressly articulated. The test for combining

references is what the combination of disclosures taken as a whole would suggest to one of

ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are

evaluated by what they suggest to one versed in the art, rather than by their specific

disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. In this case the prior art cited

deals with the generalized problem of conducting electronic transactions..

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713.

The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685